

REMARKS

Upon entry of the present amendment, claims 1, 4, 7, 10 and 15 will have been amended while claim 14 will have been canceled. In view of the herein contained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections set forth in the above-mentioned Official Action. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants respectfully thank the Examiner for confirming receipt of the drawings filed on December 29, 2004 and for indicating that these drawings are acceptable.

In the outstanding Official Action, the Examiner rejected claims 1-19 under 35 U.S.C. § 112, first paragraph. The Examiner asserted that the claims fail to comply with the written description requirement. In response to the Examiner's rejection and without in any manner acquiescing the in the propriety of the Examiner's rejection, Applicants have deleted the term "non-deformably" from each of the claims. Such action is taken only in order to advance the prosecution of the present application by eliminating the basis for this rejection. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-19 under 35 U.S.C. § 112, first paragraph.

In the outstanding Official Action, the Examiner rejected claims 1-4, 7-11 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Applicants admitted prior art (Admission) in view of JP 10-15661. The Examiner further rejected claims 5, 12 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Applicants admitted prior art in view of JP 10-15661 and further in view of CROUT et al. (U.S. Patent No. 5,333,918). Claims 6, 13 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants

admitted prior art in view of JP 10-15661 and further in view of HUMPSTON et al. (U.S. Patent No. 6,732,905). Applicants respectfully traverse the above rejections and submit that they are inappropriate.

By the present Response, Applicants have amended each of the independent claims by inserting features related to the recitations of claim 14 therein. Accordingly, as now recited in each of independent claims 1, 7 and 15, the base blocking protrusion, the groove blocking protrusion or the first blocking protrusion is now recited as having a flat upper surface and a smooth end surface. It is respectfully submitted that the combination of features now recited in each of Applicants independent claims 1, 7 and 15 is not taught, disclosed nor rendered obvious by the Examiner's proposed combination of references.

In addressing the rejection of claims 1-4, 7-11 and 14-17, the Examiner explicitly admitted that the "admitted" prior art fails to disclose the inclusion of a base blocking protrusion or a groove blocking protrusion. Thus, the Examiner relied on JP 10-15661 for this feature. However, even the Examiner's proposed combination, as admitted by the Examiner, does not disclose (expressly or otherwise) that the groove (or base) blocking protrusion has a flat upper surface and a smooth end surface. However, the Examiner asserts that this feature is a "obvious matter of design choice to a person of ordinary skill in the art". The Examiner's assertion is submitted to be inaccurate and the Examiner's rejection is thus respectfully traversed.

Initially, Applicants note that the JP 10-15661 is not merely silent with respect to the characteristics of the upper and end surfaces of the protrusion but explicitly teaches them to have a surface characteristic that are directly contradicted by the recitations of Applicants claim. Thus, the Examiner's position actually relates to a modification of the

disclosure of a secondary reference. Such modification of the reference cannot be rendered obvious by the Examiner's mere designation thereof as a "matter of design choice". An assertion of "design choice" is merely a desired conclusion that has to be supported by appropriate evidence. Such evidence has not been submitted in the present application and accordingly, for this reason alone, it is respectfully submitted that the Examiner's rejection is inappropriate.

The Examiner asserts that having a flat upper surface and a smooth end surface is not disclosed to provide any advantages, to be used for a particular purpose or to solve a stated problem. It is respectfully submitted that in this regard also the Examiner is incorrect.

The provision of flat upper surface and smooth end surface provides significant advantages in maintaining the adapter ring 19 and the radial member 28 in co-axial alignment and in preventing either the adapter ring or the radial member from shifting obliquely which, as is apparent, would interfere with the efficient operation of the reciprocating member.

In this regard, Applicants note that the JP 10-15661 relates to the joining of pipes rather than coupling for a reciprocating member. In joining of pipes there is no particular reason to maintain a precise axial relationship between the joined pipes. However, on the contrary in the present invention, such co-axial positioning is important and is an advantage that results from the use of a flat upper surface and a smooth end surface as recited in each of Applicants claims.

It is quite clear that utilization of plural spaced deformable protrusions of JP 10-15661 would result in significant play or variation in the final positioning of the pipes with

respect to each other. This would be totally acceptable in the environment to which the present application is directed. On the other hand, the provision of a flat upper surface and a smooth end surface provides the precise and accurate positioning of the various members with respect to each other to provide a significant benefit in the reciprocating device of the present invention.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection applied against the claims in the present application.

Applicants note that the status of the present application is after Final Rejection and with respect to such status one does not have a right to amend an application. However, it is respectfully submitted that entry of the present amendment is in accordance with 37 C.F.R. § 1.116 and is thus respectfully requested.

In particular, Applicants amendment merely incorporates subject matter related to the recitations of claim 14 into each of the independent claims. Since claim 14 has already been considered by the Examiner, it is respectfully submitted that the present amendment does not raise any new issues requiring further consideration or search and also does not raise the question of new matter. In this regard, Applicants note that explicit support for the features now recited in Applicants claims, in addition to being provided by original claim 14, is also clearly shown in at least Fig. 5 of the present application.

Moreover, the present amendment clearly places the application in condition for allowance and it is thus respectfully submitted that entry thereof is appropriate and proper and is thus respectfully requested.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have canceled one claim and have incorporated features related to the canceled claim into each of the independent claims of the present application.

Moreover, Applicants have discussed the various rejections asserted by the Examiner and have shown them to be inappropriate. Applicants have canceled the terminology that the Examiner rejected as not complying with the written description requirement under 35 U.S.C. § 112, first paragraph. Applicants have further discussed the disclosure of the references relied upon under 35 U.S.C. § 103 and have pointed out the significant and substantial shortcomings thereof with respect to the combination of features recited in Applicants claims. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect in due course.

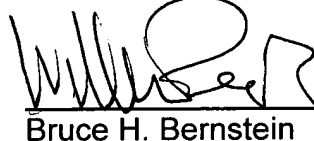
Applicants have further discussed the status of the present application as being after Final Rejection and with respect to such status, have provided a basis for the propriety of the entry of the present amendment in accordance with the provisions of 37 C.F.R. § 1.116.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

P23589.A05

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Reuven UNGER et al.

  
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